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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,147	02/16/2001	Kevin H. Gillespie	06129-158001	4293

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EXAMINER

PATTERSON, MARIE D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 05/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/788,147

Applicant(s)

GILLESPIE, KEVIN H.

Examiner

Marie Patterson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17-23 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-23, and 26-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. Claims 1-15, 17-23, and 26-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 22, and 26 the phrase “said aperture, said lower cushion surface of said first cushion, exposed at the aperture” is awkward, confusing, vague, and indefinite.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 8, 11, 13-15, 17, 22, 23, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Schenkel (Brazil publication PI 9800597-9).

Schenkel shows a shoe comprising an outsole (formed by C, T, S, and R) with apertures (VT and VD), and cushions (E) which are located, flow (“to deform under stress without cracking or rupturing” as defined by Websters Dictionary) and bulge through the apertures (as shown in figures 5, 6, and 8-10) but do not contact the ground surface (as shown in figures 6, 8, 9, and 10) as claimed.

4. Claims 1, 4-6, 11, 12, 15, 17, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Fuerst (4897936).

Fuerst shows a shoe with an outsole with apertures (28 and 30) and inserts (50 and 52) therein which bulge and protrude through the apertures as claimed. In reference to the functional recitation of "said lower cushion surface...being spaced...at all times..." is considered an intended use recitation and encompassed by the use of walking which is discussed by Fuerst in column 1 line 65-column 2 line 2).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 11, 15, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Preston (5287638) in view of Fuerst.

Preston shows a shoe with an aperture (21) and cushion (24) in the heel of an outsole and a recess in the lower surface of the outsole (figure 3) substantially as claimed except for the exact depth of the recess in the lower surface of the outsole. Fuerst teaches providing a recess in the lower surface of an outsole with a recess wall and an insert (52) located within the recessed region and the recess being of such a depth that the insert is spaced above the ground surface at all times in which the wearer is walking (column 1 line 65- column 2 line 2). It would have been obvious to make the recess of sufficient depth as taught by Fuerst in the shoe of Preston to prevent excessive wear on the insert and thereby extend the useful life of the shoe.

In reference to claims 2 and 3, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use rubber and thermoplastic resins, since it has been

held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

7. Claims 1 and 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duclos (4724624) in view of Fuerst.

Duclos shows a shoe comprising an outsole with a grid pattern and loop (figure 2) substantially as claimed except for an aperture in the heel with a cushion. Fuerst teaches providing an insert (52) in an aperture in the heel of an outsole and a recess in a lower surface of the outsole (figure 3). It would have been obvious to provide an aperture, recess, and cushion as taught by Fuerst in the shoe of Duclos to increase cushioning and shock absorption.

8. Claims 1 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parisotto (5768806) in view of Fuerst.

Parisotto shows a shoe comprising an outsole with a grid pattern on the top surface of the outsole (figure 1) substantially as claimed except for an aperture in the heel with a cushion. Fuerst teaches providing an insert (52) in an aperture in the heel of an outsole and a recess in a lower surface of the outsole (figure 3). It would have been obvious to provide an aperture, recess, and cushion as taught by Fuerst in the shoe of Parisotto to increase cushioning and shock absorption.

9. Claims 1, 5, 6, 11, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dyer (5325611) in view of Fuerst.

Dyer shows a shoe substantially as claimed except for a recess in the lower surface of the outsole. Fuerst teaches providing a recess in the lower surface of an outsole with a depth so that

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the insert (52) does not engage the walking surface during weight bearing and heel strike force during normal walking conditions at all times (see column 1 line 65- column 2 line 2). It would have been obvious to make the recess of a sufficient depth as taught by Fuerst in the shoe of Dyer to increase cushioning and to prevent excessive wear on the insert and thereby extend the useful life of the shoe.

10. Claims 1, 3, 4, 12, 15, 17-23, and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavone (6009637) in view of Fuerst.

Pavone shows a shoe substantially as claimed except for a recess in the lower surface of the outsole. Fuerst teaches providing a recess in the lower surface of an outsole with a depth so that the insert (52) does not engage the walking surface during normal play at all times under normal play (see column 1 line 65- column 2 line 2). It would have been obvious to make the recess of a sufficient depth as taught by Fuerst in the shoe of Pavone to prevent excessive wear on the insert and thereby extend the useful life of the shoe.

Response to Arguments

11. Applicant's arguments filed 5/8/03 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards Schenkel, the insole of Schenkel is made from "a resilient material having shock-absorbing characteristics ... polyurethane" (column 4 lines 15-23) and states that the insole is allowed to "protrude or bulge in a generally downward direction through cutouts 28 and 30" (column 3 lines 11-12). The dictionary definition of "flow" is "to deform under stress without cracking or rupturing" as defined in Webster's Dictionary and the material which protrudes and bulges under force is considered to "flow". It is not understood

what other definition of flow applicant is arguing or what specific limitations applicant is intending on encompassing with the term “flow”.

In response to applicants’ arguments directed towards Fuerst, Fuerst clearly states “said central portion is not ground engaging in normal play but engages the ground under appropriate player weight distribution conditions” (column 1 line 67- column 2 line 2). If the wearer does not at any time provide excessive force, i.e. sufficient weight distribution conditions, i.e. the only conditions in which the shoe is used is “normal play” or less force conditions such as merely walking, the central portion would be spaced above the floor or ground surface at all times as claimed. It is not that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). It is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. *In re Swinehart*, 169 USPQ 226 (CCPA1971). The structure of Fuerst is clearly capable of performing the function “said lower cushion surface of said first cushion...being spaced by ...at all times” especially when the wearer is low weight, participates in low force activities, etc..

In response to applicants' arguments directed towards Pavone, the cushion is made of silicone material inflated with helium (see column 2 lines 50-65) and the outsole is made from a hard rubber (column 2 line 47) and since the outsole is made from a hard material and provides the aperture under the silicone material, the silicone will inherently bulge, flow, be forced down through the aperture in the hard rubber sole to some extent due to the materials used and the force applied. It is not an invention to perceive that the product which others had discovered had qualities they failed to detect. (National Distillers and Chemical Corp. v. Brenner, 156 USPQ 163, 854 OG 844).

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and

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applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson
Primary Examiner
Art Unit 3728